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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,827	10/11/2001	Mitsuyuki Hatanaka	275785US6	2274
22850	7590	07/26/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			GYORFI, THOMAS A	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,827

Applicant(s)

HATANAKA ET AL.

Examiner

Tom Gyorfi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-19, 21-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-19, 21-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-15, 17-19, 21-23, and 25 remain for examination. The correspondence filed 5/12/06 amended claims 14, 18, and 22; and cancelled claims 16, 20, and 24.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/12/06 has been entered.

Response to Arguments

3. Applicant's arguments filed 5/12/06 with respect to claims 1-13 have been fully considered but they are not persuasive. As Applicant has added no additional arguments beyond those originally supplied in the After-Final Amendment of 3/21/06, the response to Applicant's current arguments against these claims can be found in the Advisory Action of 4/28/06 (page 2, 1st and 2nd paragraphs).

4. Applicant's arguments with respect to claims 14, 15, 17-19, 21-23, and 25 have been considered but are moot in view of the new ground(s) of rejection, although Examiner wishes to note that the general limitation of automatically selecting content on a recording medium was well known in the art (see enclosed definition of "AutoPlay").

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-4, 6-7, 9-10, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura et al. (U.S. Patent 6,034,832) and further in view of Berman et al (U.S. Patent 6,502,194).

Referring to Claims 1, 3 and 4:

Ichimura discloses an information processing apparatus having functions for recording contents recorded on a first recording medium onto a second recording medium, said apparatus comprising: recording means for recording the contents of the first recording medium onto the second recording medium (col. 2, lines 5-20);

storing means for storing information regarding each track of the contents as recording history information at the time of the contents recorded of the first recording medium being recorded onto said second recording medium by said recording means (col. 2, lines 15-30; col. 8, lines 34-41; col. 11, lines 5-10; col. 13, lines 20-35); and

means for determining whether a track on the first recording medium was previously recorded or not by said recording means based on said recording history information (col. 15, lines 15-30; col. 22, lines 45-60).

Although Ichimura discloses a display means (col. 8, lines 1-5), it is unclear from that disclosure as to what information can be displayed on said display means.

However, Berman discloses an invention comprising a method of transferring copy

protected content onto a recording medium, utilizing a display means allowing one to select tracks for recording (col. 13, line 50 – col. 14, line 10, and Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a display means displaying information regarding a track that was not previously determined by said determining means, wherein said display means initially indicates the track that was not previously recorded as being selected for recording by said recording means from the first recording medium to the second recording medium (i.e. displaying information already maintained by Ichimura as noted above). The motivation for doing so would be to display all information regarding the operational status of the apparatus in a user-friendly manner (Ichimura, col. 8, lines 1-5; Berman, col. 3, lines 55-60).

Referring to Claim 2.

Ichimura and Berman disclose the limitations of Claim 1 above. Ichimura further discloses said recording history information contains audio recording history information which records the number of times that audio recording has been made for each track of the first recording medium, title saving information of the contents, and play list information (col. 5, line 60-col 6, line 15; col. 8, lines 25-50).

Referring to Claims 6, 9, and 12:

Ichimura and Berman disclose or suggest the limitations of claims 14, 18, and 22 above. Berman further discloses wherein said display means is configured to display

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indicia indicating manual selection or deselection of tracks for recording by said recording means from the first recording medium to the second recording medium (col. 13, line 50 – col. 14, line 10).

Referring to Claims 7, 10, and 13:

Ichimura and Berman disclose or suggest the limitations of claims 1, 3, and 4 above. Berman further discloses means for displaying indicia indicating whether or not recorded history information is present in said apparatus for the contents of the first recording medium (col. 13, line 50 – col. 14, line 10).

7. Claims 5, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura and Berman as applied to claims 1, 3, and 4 above, and further in view of Epstein (U.S. Patent 6,601,046).

Referring to Claims 5, 8, and 11:

Ichimura and Berman disclose or suggest all the limitations of claims 1, 3, and 4 above. Ichimura further discloses wherein said recording history information storing means is further configured for storing information regarding the contents as recording history information at the time of the contents recorded onto the second recording medium being rendered unusable (col. 9, lines 25-45). Neither Ichimura nor Berman apparently disclose checking-in means for rendering unusable the contents recorded on the second medium from the first medium wherein said recording history information

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includes a check-out number which is decremented when said recording means records the contents on the first recording medium onto the second recording medium and is incremented when said checking in means renders unusable the contents recorded onto the second recording medium. Epstein discloses these limitations (col. 2, lines 22-39; col. 3, line 45 – col. 4, line 26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a check-out mechanism similar to that disclosed by Epstein as part of the recording history information disclosed by Ichimura. The motivation for doing so would be to balance the copyrights of the owner of intellectual property with the fair-use rights of the purchasers, for example by minimizing the damage caused by a loss of a copy (Epstein: col. 2, lines 13-21).

8. Claims 14, 15, 17-19, 21-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichimura and Berman above, and further in view of Mori et al. (U.S. Patent 6,208,802).

Referring to Claims 14, 18, and 22:

Ichimura discloses a method for transferring contents from a first recording medium to a second recording medium, said apparatus comprising means for determining whether or not recorded history information is present in said apparatus for the contents of the first recording medium (col. 14, lines 3-8); means for recording the selected portion of the contents from the first medium to the second recording medium (col. 16, lines 15-25); means for storing recorded history information regarding the

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selected portions of the contents recorded from the first recording medium to the second recording medium (col. 18, lines 1-25).

Ichimura appears to be silent regarding the user interface required to operate that invention. Although it provides means for per-track copy protection (col. 8, lines 34-41) and a display unit (col. 8, lines 1-5), it does not explicitly disclose means for selecting a portion or portions of the contents for recording from the first recording medium to the second recording medium and means for displaying indicia indicating the selected portion or portions, wherein said recording means records from the first recording medium to the second recording medium the displayed selected portion or portions. However, Berman discloses these limitations (col. 13, line 50 – col. 14, line 10). It would have been obvious to one of ordinary skill in the art at the time to provide a detailed user interface, such as that found in Berman, to the invention disclosed by Ichimura. The motivation for doing so would be to display all information regarding the operational status of the apparatus in a user-friendly manner (Ichimura, col. 8, lines 1-5; Berman, col. 3, lines 55-60).

Neither Ichimura nor Brennan appear to disclose wherein the selection step initially, automatically selects portions of the contents of the first recording medium for recording that do not have recorded history information present in said apparatus. However, Mori discloses this limitation (col. 37, lines 5-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the process of Ichimura in view of Berman to be initiated automatically as disclosed by Mori. The

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motivation for doing so would be to eliminate the need for pressing a "play" key while still permitting copying as intended by the author (Mori, col. 37, lines 10-15).

Referring to Claims 15, 19, and 23:

Ichimura, Berman, and Mori disclose or suggest the limitations of claims 14, 18, and 22 above. Berman further discloses wherein said selecting means is configured to allow manual selection or deselection of portions of the contents of the first recording medium for recording from the first recording medium to the second recording medium (col. 13, line 50 – col. 14, line 10).

Referring to Claims 17, 21, and 25:

Ichimura, Berman, and Mori disclose or suggest the limitations of claims 14, 18, and 22 above. Berman further discloses means for displaying indicia indicating whether or not recorded history information is present in said apparatus for the contents of the first recording medium (col. 13, line 50 – col. 14, line 10).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: "Microsoft Press Computer Dictionary, Third Edition", page 37.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG
7/21/06



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